

REMARKS

This amendment is responsive to the Office Action dated March 14, 2006. In the office action the Examiner rejected claims 1 and 9 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,826,387 (application serial no. 09/728,025) to Kammer. The Examiner acknowledges that the conflicting claims are not identical, but takes the position that the claims presented here are not patentably distinct from those that issued in U.S. Patent No. 6,826,387.

In particular, with respect to the claims presented here, the Examiner takes the position that steps are shown in the prior patent to Kammer (U.S. Patent No. 6,826,387). Although the Applicant believes that the claims presented here are different, to expedite allowance of this application, he is submitting a terminal disclaimer. This terminal disclaimer is submitted to overcome the obviousness type double patenting rejection. With this terminal disclaimer, the owner or assignee with 100 percent interest in this application disclaims (under the conditions indicated in the terminal disclaimer) the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of prior patent 6,826,387. The Examiner is respectfully requested to withdraw his rejection of the claims pending in this application and to allow them.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Singhal et al. (U.S. Patent No. 6,633,761) in view of Shuster et al. (U.S. Patent No. 6,633,761). The Examiner takes the position that Singhal et al., discloses all the claimed elements other than the feature of a transceiver comprising the step of executing an application, wherein the application is a legacy application operable to communicate with a peripheral device over a serial connection. The Examiner relies on Schuster et al., for filling that void, taking the position that Schuster et al., is from the same field of endeavor. Applicant respectfully submits that there is no suggestion in Singhal et al. that invites a combination in the manner that the Examiner suggests. Applicant respectfully traverses that it would have been obvious to combine the references as the Examiner suggests and urges the Examiner to reconsider the rejections in view of the following reasoning set forth below.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Application No.:
Reply to Office Action of:

10/769,176
March 14, 2006

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,
BERRY & ASSOCIATES P.C.

Dated: September 14, 2006

9255 Sunset Blvd., Suite 810
Los Angeles, CA 90069
(310) 247-2860

By: /ReenaKuyper/

Reena Kuyper
Registration No. 33,830